

REMARKS

Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 1-6 are presently pending before the Office, with claims 7-34 having been withdrawn from consideration due to a restriction requirement. No claims have been canceled. Applicants have amended the specification to correct a translation error and the claims. No new matter has been added. Support for the amendments can be found throughout the specification as originally filed. Applicants are not intending in any manner to narrow the scope of the originally filed claims.

The Examiner's Action mailed May 13, 2003 (Paper No. 17) and the references cited therein have been carefully studied by Applicants and the undersigned counsel. The amendments appearing herein and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

The Examiner has rejected claims 1-6 under 35 USC 112, first paragraph, for the reasons stated in the Office Action in paragraph 4. Applicants respectfully request that the rejection be withdrawn.

The phrases "alkyl optionally substituted by alkoxy" are supported by "methoxymethyl" in the specification on page 27, line 6.

The phrases "alkoxy optionally substituted by halogen or aryl" are supported by trifluoromethoxy and benzyloxy (phenylmethoxy) in the specification on page 27, line 9.

The phrases "optionally substituted by alkoxy" do not modify the phrase "aryloxy", but rather the phrase "aryl or aryloxy."

Accordingly, Applicants submit that the phrase "alkyl optionally substituted by alkoxy" does not constitute matter unsupported by the specification.

Relying on 35 U.S.C. §112, second paragraph, the Office has rejected the subject matter of claims 1-6 as being indefinite for failing to particularly point out and distinctly claim the

subject matter which Applicants regard as the invention for the reasons stated on page 4 of the Office Action. Applicants respectfully request reconsideration.

Applicants submit that claims 1-6 do define the legal metes and bounds of the invention. It is not the role of the claims to enable one skilled in the art to reproduce the invention but rather to define, for those skilled in the art the legal metes and bounds of the invention. Nevertheless, in order to advance the case to allowance, the claims have been amended to correct the spelling of the word "optionally" in claims 1 and 5.

Regarding the phrase "heterocyclic group" deemed indefinite by the Examiner, Applicants are at a lost regarding why the Examiner feels it is indefinite. It is understood that a heterocyclic ring is a broader term that embraces heteroaryl. However, "aryl" also embraces heteroaryl. The expression as further used in the claim defines the substituents. The Examiner asks "can the ring be fused, the number and nature of the heteroatoms, etc. " The claim can be defined by the specifications and it is clear what is meant by the phrase. For example, see page 27 lines 4-16 where it is stated:

For the compounds represented by the general formula (I), as examples for the group represented by R_1 , hydrogen, halogene, such as chlorine and fluorine, optionally substituted alkyl, such as methyl, isopropyl, methoxymethyl, methylthiomethyl, chloromethyl, trifluoromethyl, trichloromethyl and monofluoromethyl, optionally substituted alkoxy, such as methoxy, isopropoxy, benzyloxy and trifluoromethoxy, a group containing an alicyclic structure, such as cyclopropyl and cyclohexyl, a group represented by a formula of $R_3S(O)_q$, such as methylsulfenyl and methylsulfonyl, a group represented by a formula of R_4R_5N , such as dimethylamino, a group represented by a formula of $R_6C(=O)$, such as acetyl, nitrile, nitro, a group represented by a formula of $CH_3C(=NCH_3)$, optionally substituted aryl, such as phenyl, 4-methoxyphenyl and 2,4-dichlorophenyl, optionally substituted aryloxy, such as phenoxy and 4-chlorophenoxy, **optionally substituted heterocyclic group, such as 2-pyridyl, 6-chloro-2-pyridyl and 4-tetrahydropyranyl, optionally substituted heteroaryloxy, such as 2-pyridyloxy and 1,3-dimethyl-5-pyrazoloxy and optionally substituted aralkyl, such as benzyl and 4-chlorobenzyl, can be given. (Emphasis added).**

(Similar definitions can be found on pages 31, 46, 55, 60 and 87. One skilled in the art can certainly comprehend the invention limitations given the specification, as disclosed.)

It is respectfully submitted that claims 1-6, as amended, fully comply with 35 U.S.C. §112, second paragraph. Withdrawal of the rejection is respectfully requested.

Relying on 35 U.S.C. §102(b), the Examiner has rejected the subject matter of claims 5 and 6 as being anticipated by Sunley et al. Applicants respectfully traverse the rejection and request reconsideration.

Applicants respectfully submit that it is important to note that, historically, the Office and the Federal Circuit has required that for a §102 anticipation, a single reference must teach (i.e., identically describe) each and every element of the rejected claim. The Office has steadfastly and properly maintained that view.

The Sunley patent fails this test. Sunley only teaches the synthesis of methyl substituted benzyloxy pirimidins. To the contrary, Claim 5 claims a compound having a formula (I) wherein R1 is pirimidinyloxymethylphenyl and claim 6 is a compound having a formula (II).

Accordingly, each and every element of Applicants' claims have not been taught in that single reference. Applicants respectfully submit that claims 5-6 have not been anticipated by the Clough patent under 35 U.S.C. §102(b), and respectfully request that such rejection be withdrawn.

CONCLUSION

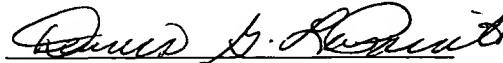
Even though the initial claims in this important patent application were drawn to a new, useful and nonobvious invention, they have now been amended to increase their specificity of language. Applicants respectfully submit that claims 1-6 are patentable over the art of record.

A Notice of Allowance is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 538-3800 would be appreciated.

Very respectfully,

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